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Filing date: **07/18/2014**

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE  
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

Proceeding	91215449
Party	Defendant Nuclear Wine Company LLC
Correspondence Address	ANDREW J GRAY IV MORGAN LEWIS & BOCKIUS LLP TWO PALO ALTO SQUARE SUITE 700, 3000 EL CAMINO REAL PALO ALTO, CA 94306 UNITED STATES trademarks@morganlewis.com, jennifer.evans@morganlewis.com, agray@morganlewis.com, pneely@morganlewis.com
Submission	Motion to Amend/Amended Answer or Counterclaim
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Date	07/18/2014
Attachments	(25229278)_(1)_LUM_NUC - Applicant_s Motion for Leave to File Amended Answer to add Counterclaim dated 7-18-14.pdf(404188 bytes )



distinguish its application, Opposer made particular representations to the Examining Attorney regarding the channels of trade for its goods. Opposer's representations persuaded the Examining Attorney to issue Opposer's Registration Number 3,953,059. Opposer now seeks to betray those representations in its Opposition and obstruct the registration of Applicant's mark. A restriction to the identification of goods identified in Opposer's mark would hold Opposer to the channels of trade it asserted to persuade the Examining Attorney to allow its application to register and would avoid a likelihood of confusion with Applicant's goods. Therefore, Applicant respectfully requests the Board grant its Motion to amend its Answer to add a counterclaim for partial cancellation.

Rule 15(a) of the Federal Rules of Civil Procedure provides that leave to amend pleadings shall be freely given when justice so requires. Accordingly, the Patent and Trademark Office liberally grants motions to amend where the other party will not be prejudiced thereby. *Cool-Ray, Inc. v. Eye Care, Inc.*, 183 U.S.P.Q. (BNA) 618, 1974 WL 20036 at \*3 (T.T.A.B. 1974). In particular, Federal Rule of Civil Procedure 13(f), which is made applicable to Board proceedings by Trademark Rule 2.116, provides that "when a pleader fails to set up a counterclaim through oversight, inadvertance, or excusable neglect, or when justice requires, he may, by leave of court, set up the counterclaim by amendment." *See 's Candy Shops Inc. v. Campbell Soup Co.*, 12 U.S.P.Q.2d 1395 (T.T.A.B. 1989). In deciding whether to grant leave to add an omitted counterclaim under Rule 13(f), the same standards governing Rule 15(a) apply. *Id.* at 1396 (reading Rule 13(f) in conjunction with Rule 15(a)).

Here, Opposer will not be prejudiced by Applicant's requested amendment. This proceeding is still in the pretrial stage and Applicant has not delayed in bringing the instant motion. *See Commodore Elec. Ltd. v. CBM Kabushiki Kaisha*, 26 U.S.P.Q.2d 1503 (T.T.A.B.

1993); *United States Olympic Comm. v. O-M Bread Inc.*, 26 U.S.P.Q.2d 1221 (T.T.A.B 1993); *Focus 21 Int'l Inc. v. Pola Kasei Koygo Kabushiki Kaisha*, 22 U.S.P.Q.2d 1316 (T.T.A.B. 1992); *see also* TBMP §507.02. Applicant brings the instant motion within weeks of receiving Opposer's initial discovery requests and long before the close of discovery.

Also, Applicant's Answer placed Opposer on fair notice of Applicant's grounds for a partial cancellation counterclaim. Applicant's Answer specifically addresses Opposer's representations to the Examining Attorney for the asserted registration that Opposer's use of LUMEN for water is limited to sales to "couture establishments." In particular, in Opposer's Response to Office Action while prosecuting its trademark application for LUMEN in connection with "drinking water," Opposer distinguished its registration from U.S. Registration Number 2,847,190 for LUMENE in connection with "mineral and aerated waters" on the basis that Lumen Water sells its drinking water "exclusively to couture establishments." This prosecution history was addressed in Applicant's Answer, and proves that the goods of Applicant and Opposer will never be sold in the same establishments. Therefore, because Opposer was placed on notice of a possible claim for partial cancellation, Opposer will not suffer any prejudice from the proposed Amended Answer and Counterclaim.

Indeed, any evidence that Opposer could use to oppose the new counterclaim is already in Opposer's possession. *See, e.g., Hurley Int'l LLC v. Paul & JoAnne Volta*, 82 U.S.P.Q.2d 1339, 1341, 2007 WL 196407 (T.T.A.B. 2007) (granting motion for leave to amend opposition to add fraud claim because "all evidence relevant to the claim...that may benefit applicants is already in the applicants' possession and control"). To the extent that Opposer needs to take any additional discovery to defend against Applicant's counterclaim, Opposer will have ample opportunity to do so.

**CONCLUSION**

WHEREFORE, Applicant respectfully requests that the Board grant its motion to file the accompanying Amended Answer to Notice of Opposition and Counterclaim. The additional fee is submitted herewith.

Dated: 7/18, 2014

Respectfully submitted,

By: \_\_\_\_\_

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### **CERTIFICATE OF SERVICE**

I hereby certify that a true and correct copy of the foregoing Motion for Leave to File Amended Answer to Add Counterclaim has been served on Opposer's attorney, Dyan M. House, Carter Scholer Arnett Hamada & Mockler, PLLC, 8150 N. Central Expy., 5th Floor, Dallas, TX 75206, via Federal Express on this 18 day of July, 2014.

  
Diana Medina

# **EXHIBIT 1**





1. Nuclear Wine Company LLC is a California limited liability company, having a principal place of business at 1727 Prospect Avenue, Santa Barbara, California 93103. Applicant otherwise denies any other allegations in Paragraph 1 of the Notice.

2. Applicant is without knowledge or information sufficient to form a belief as to the truth of the allegations in Paragraph 2 of the Notice and, on that basis, denies them.

3. Applicant is without knowledge or information sufficient to form a belief as to the truth of the allegations in Paragraph 3 of the Notice and, on that basis, denies them.

4. Applicant is without knowledge or information sufficient to form a belief as to the truth of the allegations in Paragraph 4 of the Notice and, on that basis, denies them.

5. The allegations in Paragraph 5 of the Notice constitute conclusions of law or legal argument to which no responsive pleading is necessary and, on that basis, Applicant denies them.

6. Denied.

7. Denied.

8. Denied.

9. Denied. In prosecuting the trademark application that led to U.S. Registration Number 3,953,059 for LUMEN in connection with “drinking water” in International Class 32, the applicant for that registration distinguished and persuaded the Examining Attorney at the U.S. Patent and Trademark Office to allow the application for the ‘059 Registration over U.S. Registration Number 2,847,190 for LUMENE in connection with “mineral and aerated waters” in Class 32 on the basis that Lumen Water sells its drinking water “exclusively to couture establishments.” Applicant Nuclear Wine Company, in contrast, is a small producer of artisan wines in Class 33 that it crafts and sells in California, primarily through direct sales through its

wine club to relatively sophisticated and knowledgeable wine drinkers. The goods of Applicant and Opposer will never be sold in the same establishments.

10. Denied.

11. Applicant admits that it filed the Application as indicated in the records of the U.S. Patent and Trademark Office, and that the Application was examined without any objection and subsequently published in the Official Gazette of the U.S. Patent and Trademark Office on the date indicated. Applicant otherwise denies any other allegations in Paragraph 11 of the Notice.

12. Denied.

13. Applicant is without knowledge or information sufficient to form a belief as to the truth of the allegations in Paragraph 13 of the Notice and, on that basis, denies them.

14. Applicant is without knowledge or information sufficient to form a belief as to the truth of the allegations in Paragraph 14 of the Notice and, on that basis, denies them.

15. Denied.

16. Denied.

### **AFFIRMATIVE DEFENSES**

By way of further Answer, and without admitting any allegations in the Notice not otherwise admitted, Applicant Nuclear Wine Company avers and asserts the following affirmative defenses:

#### **FIRST AFFIRMATIVE DEFENSE Opposer's Alleged Mark Coexists with Identical Marks**

1. Opposer's alleged mark coexists with third party federally registered marks consisting of or containing the same LUMEN term for a range of goods and services, including water, rendering Opposer's alleged mark weak and barring any likelihood of confusion here.

**SECOND AFFIRMATIVE DEFENSE**  
**Opposer's Alleged Mark Lacks Consumer Recognition**

2. On information and belief, Opposer's alleged mark is not well known and has little if any consumer recognition, alone preventing any likelihood of consumer confusion, particularly where, as here, Applicant's mark is used for materially different goods, sold to sophisticated consumers in different classes through materially different channels of trade.

**THIRD AFFIRMATIVE DEFENSE**  
**The Marks at Issue Have Coexisted Without Confusion**

3. Despite the alleged use of both marks in commerce, there are no – and Opposer is unable to identify any – instances of actual consumer confusion, further evidencing the lack of likely consumer confusion.

**ADDITIONAL DEFENSES**

Without prejudice to the denials set forth in the foregoing Answer to the Notice of Opposition and Affirmative Defenses, and without admitting any allegations in the Notice not otherwise admitted, Applicant avers and asserts the following additional defenses:

1. Opposer's claims are barred because Opposer fails to state a claim upon which relief can be granted.

2. There is no likelihood of confusion between Applicant's mark and the asserted mark.

3. Applicant will rely on any and all other valid defenses that may be developed through discovery and/or the testimony periods in this proceeding, including that Opposer has made statements to the USPTO that it knew were not true at the time that it made them.

## COUNTERCLAIM FOR PARTIAL CANCELLATION OR RESTRICTION OF REGISTRATION

Applicant Nuclear Wine Company, LLC, pursuant to Section 18 of the Lanham Act, 15 U.S.C. §1068, requests that the Board order the Opposer's Registration No. 3,953,059 for LUMEN for "drinking water" be amended to modify the description of the goods therein. In support of its request, Applicant alleges the following:

1. Opposer represented to the Examining Attorney that it promotes and sells its drinking water under the LUMEN mark exclusively to "couture establishments" in order to obtain the allowances of Registration No. 3,953,059. Thus, likelihood of confusion with Applicant and its use of LUMEN in connection with wine could be avoided by restricting the description of services described in Registration No. 3,953,059 to the following:

"Drinking water that is offered and provided exclusively to couture establishments"

2. Because Opposer is not using the mark LUMEN in connection with goods that will be excluded from the registration if the proposed amendment is entered, this amendment will not harm Opposer.

WHEREFORE, having fully Answered the claims in the Notice, Applicant requests that

(a) the Notice be dismissed with prejudice; and

(b) Opposer's Registration No. 3,953,059 be amended as outlined above in accordance with Section 18 of the Lanham Act, 15 U.S.C. §1068.

Dated: 7/18, 2014

Respectfully submitted,

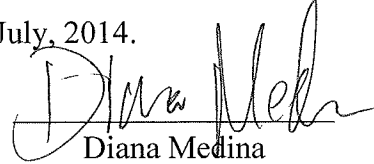
By: 

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### **CERTIFICATE OF SERVICE**

I hereby certify that a true and correct copy of the foregoing Amended Answer to Notice of Opposition and Counterclaim for Partial Cancellation has been served on Opposer's attorney, Dyan M. House, Carter Scholer Arnett Hamada & Mockler, PLLC, 8150 N. Central Expy., 5th Floor, Dallas, TX 75206, via Federal Express on this 18 day of July, 2014.

  
Diana Medina